

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 19 remain in this application. No claims have been cancelled, withdrawn, or added.

Claims 1 through 19 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Imai.

Independent Claims 1 and 10

Claims 1 and 10 each require, in part, "filtering the data to parse the data into meaningfully presentable data and non-meaningfully presentable data". This aspect of the invention permits the data, without limitation on the particular level or form of the data being filtered, to be parsed into meaningfully presentable and non-meaningfully presentable data.

With respect to these requirements of the independent claims, it is contended in the Office Action that "[i]t would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Imai et al only by a degree, e.g. in the recitation of filtering and parsing data but parsing is an inherent feature of all programs which process the requests, e.g., servers. Imai did not explicitly used the word 'filtering' but it would have been obvious to one of ordinary skill in the networking art at the time of the invention that selecting the files the way Imai et al do constitutes an obvious variation of the filtering."

Thus, even though the rejection in the Office Action appears to admit that the Imai teaching does not explicitly disclose the applicant's claimed filtering of data to parse the data, the assertion is made that the operation of the claimed invention and the Imai teaching differ "only by a degree".

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

However, the difference between the "filtering the data to parse the data" requirement of the independent claims is submitted to be significantly and patentably different than the judging of file types taught by Imai. The Imai system is limited to assessing or judging information based only upon the type of file containing that information. As a consequence of judging information only at the file level, files which may indeed contain data that is meaningfully presentable on the client as well as data that is non-meaningfully presentable on the client are discarded simply based upon the file type that contains the meaningfully presentable information. For example, word processing document file types may include image data as well as character data, and portable document file (pdf) type files may also include both types of data. In the Imai system, a judgment is made based solely upon the file type and not on whether some of the data within the file is meaningfully presentable on the client, so data that may be meaningfully presentable on the client is actually treated by Imai as non-meaningfully-presentable data if the type of file containing the data does not meet Imai's transfer condition for judging files.

In contrast, the invention of applicant's independent claims requires the consideration of the data itself without respect to any particular file type, and thus is able to consider data at a lower or finer level than simply looking at the type of file in which the data is located and judging it based only upon the file type.

Thus, it is submitted that merely because one is of the opinion that the claimed invention and a prior art teaching differ "only by a degree", that belief does not by itself, even if accurate, make the claimed invention an obvious variation of the prior art teaching. The Office Action does not set forth any particular reason why one of ordinary skill in the art would be motivated to modify the Imai system in a manner such that the Imai system would satisfy the applicant's claims. This is especially true in cases where the prior art reference leads one of ordinary skill in the art away from the

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

allegedly obvious modification necessary to make the prior art teaching correspond to the claimed invention. (A number of examples of the Imai teaching leading one of ordinary skill in the art away from the claimed invention are set forth below.)

The rejection of the independent claims also appears to rely heavily upon an allegation that the claimed "filtering the data to parse the data" is inherent in the teaching of Imai. This allegation of inherency in the Office Action effectively concedes that the Imai reference does not explicitly teach the claimed filtering of data to parse the data, while contending that the claimed filtering data to parse data is inherent in the Imai teaching, or at least inherent in programs of the type of Imai.

The United States Patent and Trademark Office ("U.S.P.T.O.") Board of Patent Appeals and Interferences has stated the burden on the Examiner is making and supporting the allegation that a feature is inherent in a teaching in the following manner:

[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Ex parte Levy, 17 USPQ 2d 1461, 1464 (B.P.A.I. 1990)

The rejection in the Office Action looks beyond the Imai disclosure and makes reference to a portion of the U.S. Patent No. 6,476,833 to Moshfeghi (hereinafter Moshfeghi) that is alleged to disclose functionality that is apparently believed by the Examiner to be inherently taught in the Imai reference regarding filtering. However, as the earliest filing date of the Moshfeghi reference was not until well after the Imai patent was filed, it is submitted that the Moshfeghi patent is no evidence of what might be inherently taught by Imai, as the Moshfeghi patent does not show that any functionality disclosed by Moshfeghi existed or was well known by those skilled in the art at the time of the Imai invention. In other words, evidence

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

of subsequent knowledge in the art after the Imai invention is not proof that that knowledge was known at the time of the Imai invention and thus "inherent" in the Imai teaching. Further, the Moshfeghi patent does not allege that the parsing described therein was known prior to the Moshfeghi invention, and therefore it cannot serve as evidence of anything that may or may not have been inherent in the system disclosed in the Imai disclosure. The Court of Appeals for the Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirg v. Kemmer*, 40 USPQ 665, 667 (C.C.P.A. 1939)) provides:

Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991) (emphasis added)

Further, if some allegedly obvious combination of the teachings of Imai and Moshfeghi is actually being relied upon in making the rejection, then it is submitted that this basis of rejection was not formally and properly set forth in the Office Action.

It is therefore submitted that the rejection of claims 1 and 10 based upon the Imai teaching cannot be maintained and allowance of claims 1 and 10, as well as the claims that depend from claims 1 and 10 and 16, is respectfully requested.

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

Independent Claim 10

Claim 10 further requires "*transmitting the data from the server to the client*" and "*filtering the data to parse the data into meaningfully presentable data and non-meaningfully presentable data on the client*" (emphasis added). These features of the invention permit the user of the client to exercise a number of options, set forth in greater detail in other claims discussed below, with respect to the non-meaningfully presentable data that would not otherwise be available to the user if the non-meaningfully presentable data is not transmitted to the client along with the meaningfully presentable data.

In the Office Action, it was asserted that "[o]ther claimed elements are all obvious variations of the well known features of networking and client server architecture. For example, it is well known to those the skill in the client server art that the programmer modifies the client code similar to the code of the server to implement features implemented on the server code. E.g., processing in the client versus on the server." The Office Action included a similar contention that "[i]t is well known to one of ordinary skill in the art at the time of invention that in client server systems it is a routine for the programmer who writes the program to divide the functions so that the server and client performs various functions. If a function is taught to be performed by the server, it is obvious to implement that functionality in the client side or code."

The Imai reference teaches a system in which "judging" of the file types against the transfer condition occurs prior to transmission of a particular file to the client, and not at the client after transmission of the particular file to the client. Imai clearly teaches the transfer of only those files that meet the display and execution capabilities of the client. See, for example, Imai at col. 27, lines 23 through 31 (emphasis added):

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

In this manner, according to the file transfer method in the procedure of FIG. 28, it is possible to transfer only those files which are selected according to the file type and the display and execution capability of the file requesting client 120 from the file server 110 to the file requesting client 120, so that it becomes possible to prevent the waste of the storage medium 121 due to the transfer of files that cannot be utilized at the file requesting client 120 and the meaningless increase of traffic in a network.

Moreover, a primary object of the Imai teaching is to enhance the efficiency of the server-client relationship by eliminating the unnecessary transfer of files from the server to the client. See, e.g., Imai at col. 2, lines 52 through 61 (emphasis added):

It is another object of the present invention to provide a file transfer method, a file server device, and a file requesting client device, capable of efficiently limiting a number of transferred files when a file transfer is not fast enough, or when an available storage medium capacity provided in a client is insufficient, or else when a file display and execution capability of a client is limited, in which already transferred file can be utilized at a client side even when a file transfer is interrupted in order to limit a number of transferred files.

Further, Imai teaches that the performance of the judging of files at the file server prior to transmission is a significant feature of the Imai system, as this aspect has two primary purposes: 1) to conserve the storage medium on the file requesting client by not transferring files that cannot be utilized by the client, and 2) to avoid a "meaningless increase" in traffic on the network employed to transfer these files. See Imai again at col. 27, lines 23 through 31 (emphasis added):

In this manner, according to the file transfer method in the procedure of FIG. 28, it is possible to transfer only those files which are selected according to the file type and the display and execution capability of the file requesting client 120 from the file server 110 to the file requesting client 120, so that it becomes possible to prevent the waste of the storage medium 121 due to the transfer of files that cannot be utilized at the file requesting client 120 and the meaningless increase of traffic in a network.

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

And at col. 28, line 66 through col. 29, line 8, Imai states (emphasis added):

In this manner, according to the file transfer method in the procedure of FIG. 29, it is possible to transfer only the selected files from the file server 110 to the file requesting client 120, by determining in advance the transfer condition according to the file type and the display and execution capability of the file requesting client 120, so that it becomes possible to prevent the waste of the storage medium 121 due to the transfer of files that cannot be utilized at the file requesting client 120 and the meaningless increase of traffic in a network.

However, the modification of Imai system set forth in the Office Action to meet the requirements of applicant's claim 10 would require one of ordinary skill in the art to modify the Imai system to not only operate in a manner substantially opposite of the actual teaching of Imai, but would also require the Imai system to be modified in a way that is completely contrary to the objectives of Imai that are evidenced by the portions of Imai quoted above. If Imai were to be modified to transmit all file types to the client before judging, then the aforementioned advantages of Imai would presumably be lost.

A modification of the Imai system that requires the complete abandonment of some of its primary objectives is not supported by the case law regarding obviousness.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

In re Gurley, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994)

And:

A reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

It is therefore submitted that one of ordinary skill in the art, considering the Imai teaching and the priority it places on conserving storage space on the client and minimizing unnecessary transmissions on the network, would not abandon these priorities and modify the Imai system to transmit the data to the client and then filter the data by parsing the data on the client, as this would, in the terms of Imai, "waste" space on the storage medium of the client and result in "meaningless" network transmissions.

Further, the case law is clear that merely because the prior art was capable of being modified to arrive at the claimed invention does not by itself provide the necessary motivation to make such a modification an obvious modification.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)

Similarly, the belief that one of ordinary skill in the art would have been capable of making such a modification is also insufficient to show that the modification would have been obvious.

The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art." The examiner then indicates that because the various aspects of the claimed process were individually known in the art, the modifications of the electrophoretic process of Levengood by exposing Levengood's plant materials to cell-associated materials in order to "graft" or otherwise incorporate the cell associated material into the plants was "well within the ordinary skill of the art at the time the claimed invention was made."

We reverse the rejection because the examiner has used the wrong standard of obviousness. . . . At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. . . .

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

Ex parte Levengood, 28 USPQ 2d 1300, 1301-02 (B.P.A.I. 1993) (emphasis added)

The statements in the Office Actions fail to set forth any reason why one of ordinary skill in the art would be motivated to make the asserted modification of the Imai teaching, and as shown above it is not sufficient to simply allege that a modification was "well known" and therefore "obvious".

It is therefore submitted that the combination of requirements of claim 10 are patentable over the prior art.

Independent Claim 10 and Dependent Claims 11 - 14 and 16 - 17

Claim 10 further requires, in part, "*processing the meaningfully presentable data on the client*". Claim 11 requires that "*the filtering of data to parse the data occurs after receipt of a complete data stream by the client from the server*". Claim 12 requires "*storing the non-meaningfully presentable data on the client*". Claim 13 requires "*transferring the non-meaningfully presentable data from the client to other devices for presentation*". Claim 14 requires that "*the step of transferring the non-meaningfully presentable data includes storing the non-meaningfully presentable date on the client prior to transfer of the data*". Claim 16 requires "*deleting the non-meaningfully presentable data from the client*". Claim 17 requires "*ignoring the non-meaningfully presentable data on the client*". (All emphasis added.)

Significantly, each of the noted claims requires the *transmission of the non-meaningful data to the client*, and then sets forth an action taken with respect to the non-meaningful data on the client. These claims are directed to aspects of the system that provide options to the user of the client for handling non-meaningfully presentable data on the client, possibly for later use. For example, storing the non-meaningfully presentable data

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

on the client permits subsequent downloading or transferring the non-meaningfully presentable data to another device for which the non-meaningfully presentable data is meaningfully presentable on that device.

As noted earlier, the Imai reference teaches a system where the files that do not meet the file type requirements of the transfer condition *are not transmitted to the client*. Imai teaches, for example, at col. 27, lines 1 through 5 (emphasis added):

When a type of the selected file does not satisfy the transfer condition, the steps S57 to S59 are executed again, to make the selection of another file and the judgment as to whether that another file satisfies the transfer condition or not.

When a type of the selected file satisfies the transfer condition, the file request unit 132 transmits the file transfer request for the specified file in the HTTP format to the file server program 150 (step S60). The file server program 150 then transfers the file specified by the file transfer request from the file request unit 132 to the file requesting client 120. This file is received by the file receiving unit 133, and stored into the cache region 121a by the file storing unit 134 (step S61).

Imai clearly teaches that only those types of files meeting the display and executing capability of the file requesting client are transferred to the client. See Imai at col. 27, lines 23 through 31 (and virtually identical language at col. 28, line 66 through col. 29, line 8, with respect to FIG. 29) (emphasis added):

In this manner, according to the file transfer method in the procedure of FIG. 28, it is possible to transfer only those files which are selected according to the file type and the display and execution capability of the file requesting client 120 from the file server 110 to the file requesting client 120, so that it becomes possible to prevent the waste of the storage medium 121 due to the transfer of files that cannot be utilized at the file requesting client 120 and the meaningless increase of traffic in a network.

It is submitted that data that is never transmitted by the Imai system to the client due to these express restrictions on data transfer in Imai would thus never be filtered after the complete data stream has reached the client (claim 11), or be able to be stored on the client (claim 12), transferred from

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

the client (claims 13 and 14), deleted from the client (claim 15), or ignored on the client (claim 17).

It is therefore submitted that none of the options for handling non-meaningful data at the client as recited in these claims is possible in the Imai system, as none of the files that fail to meet the transfer condition in Imai are transferred to the client. Further, as also noted above, the Imai patent teaches a number of reasons for not transferring the rejected files to the client (e.g., "waste" of storage space and additional load on the transmitting network), and it is submitted that these reasons could only lead one of ordinary skill in the art away from modifying Imai to perform the claimed actions. This is especially true for the requirements of the claims that are directed to the storage of the non-meaningful data on the client, as Imai clearly teaches that the storage on the client of files that cannot be utilized on the client results in the wasting of space on the storage medium of the file requesting client.

Claims 10 through 14 and 16 through 18 are therefore submitted to be allowable over the prior art.

Dependent Claims 6, 7, 8, 15, and 19

Claim 6 requires that "the step of determining the client capability for presenting data is set by *the client*". Claim 7 requires that "the step of determining the client capability for presenting data is set by *the user of the client*". Claim 8 requires that "the client configuration causes certain data to be parsed into non-meaningful data even though the client has the capability to present the certain data". Claim 15 requires that "the client configuration is alterable to provide varying degrees of user-determined capability for presenting data". Claim 19 requires that "the client is capable of providing a user with an option for setting the client configuration such that certain data will be parsed into non-meaningful data

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

even though the client has the capability to present the certain data". (All emphasis added.)

The features recited in these claims generally permit the user to alter the filtering of the data by parsing the data between the meaningfully presentable data and the non-meaningfully presentable data using factors or characteristics that are not simply based upon only the capabilities of the client.

The rejection in the Office Action lacks any particular analysis of the requirements of the requirements of these claims, and instead includes the general allegation that "[o]ther claimed elements are all obvious variations of the well known features of networking and client server architecture." However, as will be appreciated from the following analysis, these requirements are in conflict with the teachings of the Imai patent, and thus it is believed that one of ordinary skill in the art would not modify the Imai system in a manner that satisfies the requirements of these claims.

In particular, as noted earlier, the Imai patent teaches the judging of files based upon the transfer condition, which in turn is based on the "display and execution capability of the file requesting client". Again, see Imai at col. 27, lines 23 through 31 (emphasis added):

In this manner, according to the file transfer method in the procedure of FIG. 28, it is possible to transfer only those files which are selected according to the file type and the display and execution capability of the file requesting client 120 from the file server 110 to the file requesting client 120, so that it becomes possible to prevent the waste of the storage medium 121 due to the transfer of files that cannot be utilized at the file requesting client 120 and the meaningless increase of traffic in a network.

Imai teaches a direct correlation between the inability of the file requesting client to utilize the file, and the judgment whether the file meets the transfer condition. The transfer condition directly corresponds to the

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

capabilities of the client. See, for example, Imai at col. 26, lines 54 through 61 (emphasis added):

The transfer condition is for preventing a wasteful transfer of a file of a type which cannot be utilized at the file requesting client 120, in consideration to the display and execution capability of the file requesting client 120, and determined in advance according to types of files such as static image files, video image files, audio files, etc., and the display and execution capability of the file requesting client 120.

For example, Imai teaches that for a client with a display that cannot display a video image, a video image file does not meet the transfer condition; and for a client that cannot execute audio data, an audio file does not meet the transfer condition. See Imai at col. 26, lines 62 through 67 (emphasis added):

For example, in a case of using a display which cannot display the video image, the video image file does not satisfy the transfer condition. In a case of using the file requesting client 120 which does not have a function for executing the audio data, the audio file does not satisfy the transfer condition.

Thus, Imai teaches the direct correlation between the capability of the client and the transfer condition.

It is submitted that Imai does not teach, or suggest, the judging of the files by any other standard other than the transfer condition, which is based upon the actual capabilities of the file requesting client, and does not teach any alteration of the transfer condition from the actual capabilities of the client device.

Further, it is submitted, in view of Imai's aforementioned purpose of eliminating "meaningless" file transmissions to the file requesting client and "wasted" space on the storage medium of the client, that one of ordinary skill in the art would not be motivated to permit the user of the client to vary the transfer condition from the actual capabilities of the file receiving client, as permitting the user to vary the transfer condition to include any

Appln. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

files "of a type that cannot be utilized" by the file requesting client would result in meaningless transmissions and "wasted" storage, in the terms of the Imai disclosure.

In view of the foregoing, it is submitted that the teaching of the Imai patent does not suggest the "filtering the data to parse the data" requirement of the independent claims, which gives the claimed invention a decided advantage over the Imai system in handling data that is meaningfully presentable on a client, even if that meaningfully presentable data is included with non-meaningfully presentable data in a file type that might be thought incompatible with the client's capabilities.

Claim 1 requires, in part, "determining a configuration of the client for presenting data". Claim 2 requires that "the step of determining the client capability for presenting data includes monitoring availability of resources on the client". Claim 3 requires that "the step of determining the client capability for presenting data includes changing client configuration properties to reflect the availability of resources on the client". Claim 4 requires that "the step of determining the client capability for presenting data includes monitoring tasks executing on the client". Claim 5 requires that "the step of determining the client capability for presenting data includes changing client configuration properties to reflect tasks executing on the client". The requirements of these claims were not individually addressed in the rejection of the Office Action with regard to the Imai patent, and it is submitted that the specific requirements of these claims define over the Imai patent.

Withdrawal of the §103(a) rejection of claims 1 through 19 is therefore respectfully requested.

Appn. No. 10/817,654
Amendment dated July 22, 2005
Reply to Office Action mailed April 22, 2005

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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